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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,001	07/20/2006	Terri L. Dewey	25360-PCT-US	2793
30184 7590 03/11/2009 MYERS & KAPLAN INTELLECTUAL PROPERTY LAW, L.L.C. CUMBERLAND CENTER II 3100 CUMBERLAND BLVD , SUITE 1400 ATLANTA, GA 30339				
EXAMINER				
CHEUNG, CHUN HOI				
ART UNIT		PAPER NUMBER		
3728				
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03/11/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/587,001

Applicant(s)

DEWEY, TERRI L.

Examiner

CHUN CHEUNG

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/20/2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 10/31/2006
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 10/31/2006 is being considered by the examiner.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: None of the reference number mentioned in specification included in the drawing. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.
3. The drawings are objected to because page 2 of the drawing discloses two Figure 2A. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be

removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 7, 10, 14 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. In claim 7, the phrase "is selected from the group of figure, statue, cup, or trophy component" is alternative and indefinite and an improper Markush group. Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. One acceptable form of alternative expression, which is commonly referred to as a Markush group, recites members as being "selected from the group consisting of A, B, C." See *Ex parte Markush*, 1925 C.D. 126 (Comm'r Pat. 1925). It is improper to use the term "comprising" instead of "consisting of." *Ex parte Dotter*, 12 USPQ 382 (Bd. App. 1931). See MPEP 2173.05 (h). Claim 10 is incomplete because it depends on itself.

In Claim 14, applicant recites the limitation "desk accessory" in line 2-3. It is not clear and confusing to the examiner by failing to particularly point out what "desk accessory" applicant claimed as the invention. Claim 20 recites the limitation "said trophy" in line 11. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-2, 5, 7-9, 12, 14, 17-18, 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Shuen (6,237,788).

As to claim 1, Shuen discloses a storage container device comprising a storage container (20) having an open top (Figure 1); and a lid (10), said lid (10) configured to facilitate combination with said storage container (20, Figure 4), wherein said lid conceals said open top of said storage container, and wherein accessibility into said storage container is hidden (Figure 4).

As to claim 2, Shuen discloses the container further comprising a display article (155) carried by said lid.

As to claim 5, Shuen discloses said storage container and said lid define an egg-shape (Figure 2).

As to claim 7, Shuen discloses said display article (155) is a status or figures of a flower and leaves (Figure 2).

As to claim 8, Shuen discloses the lid is removable by detaching the pin between lug 156 and arm 254.

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As to claim 9, Shuen discloses said lid is hingedly related to said storage container (Figure 4, lug 156 and arm 254).

As to claim 12, Shuen discloses said lid further comprises a mounting aperture (11) for receiving display member.

As to claim 14, Shuen discloses an article carried on said lid which is inherently capable of holding a clip which is equivalent to a desk accessory.

As to claim 17, Shuen discloses said lid further comprises at least one tab member (14), wherein said storage container further comprises at least one notch (241), and wherein each said at least one tab (14) member is configured to seat within each said correspondingly dimensioned notch (241).

As to claim 18, Shaun discloses a container further comprising a hinge (Figure 4, lug 156 and arm 254), said hinge connecting said lid and said storage container (Column 2, lines 56-59).

As to method claim 20, the claims are anticipated by the method of using the container of Shuen.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 3, 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shuen (6,237,788). Shuen discloses the storage container device above having most of the limitations of the claims except for the shape of the storage container device as claimed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the storage container device of Shuen so the storage container and the lid comprise a shape as claimed because a change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. In re Dailey et al., 149 USPQ 47.

12. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shuen (6,237,788) in view of Kazuhiro (JP1167055).

As to claim 10 and 11, Shuen as discussed in claim 1 above, does not disclose said lid is magnetically related to said storage container, said storage container defines an interior peripheral edge having a first plurality of magnets carried thereon, and therein said lid carries a second plurality of associated magnets thereon, said first and said second plurality of magnets securing said lid proximate said storage container. However, Kazuhiro discloses a container (11) with lid (12) is magnetically (13a, 13b) related to said storage container, said storage container (11) defines an interior peripheral edge having a first plurality of magnets (13a) carried thereon, and therein said lid (12) carries a second plurality of associated magnets (13b) thereon, said first and said second plurality of magnets securing said lid proximate said storage container. It would have been obvious to a person having ordinary skill in the art at the time of the invention was

made to modify the storage container of Shuen with magnetic closure as taught by Kazuhiro to close said lid portion onto the container with easily undetectable mechanism.

13. Claim 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shuen (6,237,788) in view of Grant (D275,469).

As to claim 13, Shuen as discussed in claim 1 above, further discloses a decorative member (23) attached to said storage container (20). However, Shuen does not disclose a plate member attached to said storage container (20). Nevertheless, Grant discloses a plate member attached to the front surface of the base. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify the decorative member of Shuen with plate member as taught by Grant to be able to engrave name or other drawing from the end user to identify the storage container.

14. Claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shuen (6,237,788) in view of Pearson (0202959).

As to claim 15 and 16, Shuen as discussed in claim 1, does not discloses a bookend member, said bookend member having a base adapted to associate with said storage member and upright member extending from said base member. However, Pearson discloses a bookend member having a base (A) and an upright member (B) extending from said member (column 1, lines 20-27). It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify the storage container with a bookend member to hold the storage container in place without move around. Applicant discloses a phrase "adapted to", it has been held that the recitation that an element is "adapted to" perform a function is not a positive

limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

15. Claim 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shuen (6,237,788) in view of Biggs, Sr. (6,279,928).

As to claim 19, Shuen as discussed in claim 18 above, does not disclose the container device further comprising a spring-type latch mechanism. However, Biggs discloses a compartment container with doors secured by a spring type latch mechanism (column 2, lines 65-66). It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify the storage container of Shuen with spring type latching mechanism closure as taught by Biggs to close lid with secure locking mechanism and easy opening.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 1,894,450 discloses a container with figure on the lid portion. U.S. Patent No. 3,822,906 discloses a container with magnetic closure. U.S. Patent No. 5,394,989 discloses a castle with storage compartment. U.S. Patent No. 6,231,346 discloses a egg shape container with hatching device. U.S. Patent No. D264,606 discloses a combined pen holder and plaque.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHUN CHEUNG whose telephone number is (571)270-5702. The examiner can normally be reached on Monday to Friday: 7:30AM~ 5:00AM. Alt Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571)272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CHUN CHEUNG/
Examiner, Art Unit 3728

/Luan K. Bui/
Primary Examiner, Art Unit 3728